

Docket No.: 0230-0222PUS1  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Ichiro HIRAO et al.

Application No.: 10/521,454

Confirmation No.: 8799

Filed: January 14, 2005

Art Unit: 2829

For: NUCLEOSIDE OR NUCLEOTIDES HAVING  
NOVEL UNNATURAL BASES AND USE  
THEREOF

Examiner: Not Yet Assigned

**RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE**

MS PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Defective Response dated April 12, 2006, Applicant respectfully submits:

- ☒ Attached is a copy of the Notification of Defective Response.
- ☐ Attached is the Executed Declaration and Power of Attorney ☐ Original ☐ Photocopy.
- ☐ The specification attached to the executed Declaration and Power of Attorney is a true copy of the specification that was filed in the U.S. Patent and Trademark Office on January 14, 2005, including any amendments thereto (if applicable) filed on even date therewith.
- ☐ The undersigned hereby declares that "Attorney Docket No. 0230-0222PUS1" on page 1 of the attached Inventors' Declaration corresponds to Appl. No. 10/521,454 filed

January 14, 2005 entitled "NUCLEOSIDE OR NUCLEOTIDES HAVING NOVEL UNNATURAL BASES AND USE THEREOF."

☒ Attached is an English language translation of the above-identified application that was filed in a foreign language, which was previously submitted on November 29, 2005.

X See the attached Translator's Verification; or

The undersigned states that the English translation attached hereto is a true and correct translation of the application as originally filed in a foreign language.

☒ Attached are 20 sheet(s) of drawings, which were previously submitted on November 29, 2005.

☒ Attached is a date stamped return receipt postcard of the filing on November 29, 2005 reflecting the submission of the English language translation and the 20 sheets of drawings.

☐ Attached is a substitute abstract commencing on a separate sheet in accordance with 37 C.F.R. § 1.72(b).

☐ Attached is a substitute specification that complies with 37 C.F.R. § 1.52. The substitute specification does not contain new matter.

☒ Attached is an Amendment, disk and paper copy of Sequence Listing.

☐ Applicant claims small entity status under 37 C.F.R. § 1.27.

☐ Attached is a Supplemental Application Data Sheet (ADS).

☐ Submitted concurrently herewith under separate cover for recording is an Assignment.


☐ Attached is a Petition for Extension of Time.

- ☐ The Government Filing Surcharge for late filing of oath and/or declaration in the amount of \$130.00 in accordance with 37 C.F.R. §§ 1.494 and 1.492 was previously paid for concurrently with the filing of the application on January 14, 2005.
- ☐ Attached hereto is the fee transmittal listing the required fees.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: May 8, 2006

Respectfully submitted,

By  #42874  
Gerald M. Murphy, Jr.  
Registration No.: 28,977  
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(703) 205-8000  
Attorney for Applicant

Attachment(s)



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

CAm

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/521,454	Ichiro Hirao	0230-0222PUS1

INTERNATIONAL APPLICATION NO.
PCT/JP03/02342

I.A. FILING DATE	PRIORITY DATE
02/28/2003	07/17/2002

02292  
BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

**DOCKETED**

Translation/Sequence listing

CONFIRMATION NO. 8799

371 FORMALITIES LETTER



OC000000018475789\*

Date Mailed: 04/12/2006

5/12/06

## NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495)

- Priority Document
- Copy of the International Application filed on 01/14/2005
- Copy of the International Search Report filed on 01/14/2005
- Copy of IPE Report filed on 01/14/2005
- Preliminary Amendments filed on 11/29/2005
- Information Disclosure Statements filed on 01/14/2005
- Biochemical Sequence Diskette filed on 11/29/2005
- Oath or Declaration filed on 11/29/2005
- Biochemical Sequence Listing filed on 11/29/2005
- U.S. Basic National Fees filed on 01/14/2005
- Priority Documents filed on 01/14/2005

Applicant's response filed 11/29/2005 is hereby acknowledged. The following requirements set forth in the NOTIFICATION of MISSING REQUIREMENTS mailed 09/07/2005 have not been completed.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Translation of the application into English. Note a processing fee will be required if submitted later than 30 months from the priority date.
- A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing." Applicant must provide a substitute computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d).

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
- For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for Patentin Software Program Help @ [ebc@uspto.gov](mailto:ebc@uspto.gov)

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

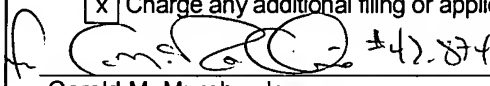
*A copy of this notice **MUST** be returned with the response.*

PATRICIA A BOOKER

Telephone: (703) 308-9140 EXT 204

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/521,454	PCT/JP03/02342	0230-0222PUS1

<b>AMENDMENT TRANSMITTAL LETTER</b>			Docket No. 0230-0222PUS1		
Application No. 10/521,454-Conf. #8799	Filing Date January 14, 2005	Examiner Not Yet Assigned	Art Unit 2829		
Applicant(s): Ichiro HIRAO et al.					
Invention: NUCLEOSIDE OR NUCLEOTIDES HAVING NOVEL UNNATURAL BASES AND USE THEREOF					
<b>MS Amendment</b> <b>Commissioner for Patents</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>					
Transmitted herewith is an amendment in the above-identified application.					
The fee has been calculated and is transmitted as shown below.					
<b>CLAIMS AS AMENDED</b>					
	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate	
<b>Total Claims</b>	10	- 20 =		x	
<b>Independent Claims</b>	3	- 3 =		x	
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					
Other fee (please specify):					
<b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:</b>					0.00
<input checked="" type="checkbox"/> Large Entity <span style="margin-left: 200px;"><input type="checkbox"/> Small Entity</span>					
<input checked="" type="checkbox"/> No additional fee is required for this amendment.					
<input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of \$ _____. A duplicate copy of this sheet is enclosed.					
<input type="checkbox"/> A check in the amount of \$ _____ is enclosed.					
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.					
<input checked="" type="checkbox"/> The Director is hereby authorized to charge and credit Deposit Account No. <u>02-2448</u> as described below. A duplicate copy of this sheet is enclosed.					
<input type="checkbox"/> Credit any overpayment.					
<input checked="" type="checkbox"/> Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.					
 Gerald M. Murphy, Jr. Attorney Reg. No.: 28,977			Dated: <u>May 8, 2006</u>		
BIRCH, STEWART, KOLASCH & BIRCH, LLP 8110 Gatehouse Road Suite 100 East P.O. Box 747 Falls Church, Virginia 22040-0747 (703) 205-8000					

Inventor: Ichiro HIRAO et al.

Atty Docket No.: 0230-0222PUS1

Application No.: 10/521,454-Conf. #8799

Filing Date: January 14, 2005

Title: NUCLEOSIDE OR NUCLEOTIDES HAVING NOVEL UNNATURAL BASES AND USE  
THEREOF

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**Documents Filed:**

- ✓ Copy of 371 Formalities letter
- ✓ Response to Notification of Missing Requirements (3 pages)
- ✓ Petition for Extension of Time
- ✓ Drawings (20 pages)
- ✓ Original executed Declaration & Power of Attorney
- ✓ Amendment (6 pages)
- ✓ Disk copy of Sequence Listing
- ✓ Paper Copy of Sequence Listing
- ✓ Check in the amount of \$120.00
- ✓ Translation of application (68 pages)
- ✓ Amendment Transmittal (1 page)
- ✓ Fee Transmittal (1 page)



Via: BSKB Courier

Sender's Initials: GMM/CAM:bmp

Due Date: December 7, 2005

Date: November 29, 2005